

OCT 14 2003

1639
PTO/SB/21 (08-03)

**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>		Application Number	10/014,318
		Filing Date	November 9, 2001
		First Named Inventor	Pallavicini, Maria G.
		Art Unit	1639
		Examiner Name	Teresa D. Wessendorf
Total Number of Pages in This Submission		Attorney Docket Number	02307O-120900US

ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply—"Response to Restriction Requirement" <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Postcard
		Remarks

The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.

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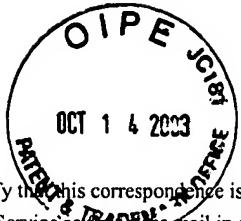
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual	Townsend and Townsend and Crew LLP Jean M. Lockyer, Ph.D.	
Signature		
Date	October 10, 2003	

CERTIFICATE OF TRANSMISSION/MAILING

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Typed or printed name	Malinda C. Dagit		
Signature		Date	10 Oct. 2003



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On 10 Oct. 2003

TOWNSEND and TOWNSEND and CREW LLP

By: Malinda Chagot

PATENT
Attorney Docket No.: 02307O-120900US
Client Ref. No.: 1997-115-1

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(1639)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

PALLAVICINI and MULLANEY

Application No.: 10/014,318

Filed: November 9, 2001

For: IDENTIFICATION OF
EXPRESSED GENES USING PHAGE
DISPLAY

Customer No.: 20350

Confirmation No.: 1486

Examiner: Teresa D. Wessendorf

Technology Center/Art Unit: 1639

**RESPONSE TO RESTRICTION
REQUIREMENT**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed September 10, 2003, Applicants elect Group I, claims 1-16, drawn to a method of identifying an exon in a eukaryotic genomic fragment. In addition, Applicants elect the following species from the subgroups set forth by the Examiner. Subgroup D is not included, as the designated claims are not in Group I.

Subgroup A: Applicants elect a binding partner that is an antibody. The claims of Group I that read on the elected species are claims 1-16.

Subgroup B: Applicants elect a stimulated B-cell library. The claims of Group I that read on the elected species are claims 1-16.

Subgroup C: Applicants elect a protein epitope encoded by the genomic sequence. The claims of Group I that read on the elected species are claims 1-16.

The species election is made with the understanding that upon the determination that the elected species is free of the prior art, additional species will be examined in accordance with MPEP § 803.02, which states that "should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended." and that "[t]he prior art search will be extended to the extent necessary to determine the patentability of the Markush-type claim."

The foregoing restriction and species elections are made with traverse. According to the MPEP, where claims can be examined together without undue burden, the Examiner must examine the claims on the merits even though they are directed to independent and distinct inventions. *See*, the MPEP at 803.01. In establishing that an "undue burden" would exist for co-examination of claims, the Examiner must show that examination of the claims would involve substantially different prior art searches, making the co-examination burdensome. Applicants respectfully submit that examination of the claims in Groups I-IV would not create an undue burden and respectfully request withdrawal of the restriction and species election requirements in this case.

Appl. No. 10/014,318
Amdt. dated October 10, 2003
Reply to Office Action of September 10, 2003

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

Jean M. Lockyer, Ph.D.
Reg. No. 44,879

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